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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: James D. Pylant et al.

Group Art Unit: 3677

Serial No.: 10/620,282

Examiner: Jack W. Lavinder

Filing Date: July 14, 2003

Attorney Docket: PI-015

Title: **BARE DIE TRAY CLIP**

**TRANSMITTAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Attached is a Reply Brief for the above-identified application. The Reply Brief is being submitted within the deadline set by the Examiner's Answer (dated April 6, 2007). Accordingly, no fee is due in conjunction with the enclosed Reply Brief. In the event a fee is due, the Commissioner is authorized to charge any fee that may be due to Deposit Account 50-2991.

Respectfully submitted,

Isabelle R. McAndrews  
Reg. No. 34,998

**Certificate of Mailing**

I hereby certify that this correspondence and the documents referred to as attached hereto are being deposited with the U.S. Postal Service with sufficient postage in an envelope addressed to the Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450.

Isabelle R. McAndrews

05-24-07

Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interference

Applicant: James D. Pylant et al.

Assignee: Peak Plastic and Metal Products

Title: BARE DIE TRAY CLIP

Serial No.: 10/620,282

Filed: July 14, 2003

Examiner: Jack Lavinder

Group Art Unit: 3677

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Commissioner for Patents  
Alexandria, VA 22313-1450

REPLY TO THE EXAMINER'S ANSWER

Sir:

In response to the Examiner's Answer dated April 6, 2007, Appellants respectfully submit the following remarks.

## REMARKS

Appellants respectfully submit that the assertions associated with the figure on page 6 of the Examiner's Answer are erroneous. The figure developed by the Examiner is the sole reference upon which each of the pending claims has been rejected. For ease of reference, the figure generated by the Patent Office (on p. 6 of the Examiner's Answer) is referred to herein as the After-Filed Figure or simply AFF.

**I. Neither AAPA nor AFF Anticipates Claims 1 – 4, 16 – 19,  
28, 30, 32 and 33 of the Present Invention**

**A. AAPA and AFF Apply Force to a Central Portion of a Stack and  
Therefore Fail to Anticipate the Claimed Invention**

The apparatus shown in Figure 4 (AAPA) of the present application is described by Appellants in their specification as a clip that applies a leverage to a central area of the bottom of the stack. The principal disadvantage of AAPA is that it applies,

a leverage to the tray, operating between each of the top prong contact points and the ... the central area of the bottom of the stack. . . . This force causes damage due to the application of the force in the thin and weak central area. (Specification, p. 2, lines 4 – 9.)

The application of a force to the central area of a stack resulted in warped trays and damage to the integrated circuits stored in the trays. Consequently, the present invention remedies the deficiencies of AAPA by providing at least two pressure members that “apply a force on a portion of the perimeter of the stack to clamp the stack together....”

Figure 4 and the accompanying description constitutes prior art and is referred to as AAPA or Appellants' Admitted Prior Art. AAPA has curved pressure members 34 that apply pressure to a central area of the bottom of a stack. In the middle of each pressure member 34 is a peak that exerts force on

the center of the stack, rather than on any portion of the stack perimeter. Consequently, AAPA does not anticipate any of the claims on appeal.

## **II. AAPA is Distorted by Speculating it is Useful to Combine AAPA with a Nonexistent Tray Size**

Nothing in AAPA teaches or suggests that the apparatus of Figure 4 is known to be used with a stack of a narrower dimension as propounded by the Examiner. In fact, there is not suggestion in AAPA that a stack having such a narrow dimension relative to the dimension of the clip even exists in the prior art. A skilled artisan would not be motivated to use an extra large clip with an extra small tray as the examiners suggest. Remolding AAPA in the manner suggested in the Examiner's Answer is tantamount to contradicting the teachings of AAPA. Since the rejection of the appealed claims is based on a distortion of AAPA, the rejection is improper.

Anticipation under 35 USC §102 requires that a reference disclose each limitation of the claim either explicitly or inherently. EMI Group North America, Inc. v. Cypress Semiconductor Corp., 60 USPQ.2d (Fed. Cir. 2001). Appellants have shown above and in their Appeal Brief how the claimed invention is not explicitly taught by AAPA or AFF. The claimed invention is also not inherently disclosed by AFF.

In the Examiner's Answer, the Patent Office postulates the unlikely possibility of combining the APA clip with a tray substantially narrower than the clip. For example, the Examiner argues as follows:

The stack [referring to the Figure on page 6 of the Answer] could also be moved off-center in the direction towards the top or bottom portion of the figure to emphasize the fact that the pressure member engages and applies a force to a portion of the perimeter of the stack. (See page 5, last paragraph of Examiner's Answer.)

If it wasn't clearly shown, [states the Examiner] one could image [sic, imagine] moving the stack slightly to the left or right directions in the channel in order for the resilient members to apply a force to a portion of the perimeter of the stack. (See page 9, penultimate paragraph of Examiner's Answer.)

The Examiners' line of reasoning is based on a probability that would not be desirable or acceptable to one of ordinary skill in the art. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Continental Can Company v. Monsanto, 20 USPQ.2d (Fed. Cir. 1991). There is simply no suggestion in AAPA that such a stack, with narrow dimensions relative to the dimensions of the tray, even exists.

Indeed the modification of AAPA to form an entirely new reference—AFF— constitutes impermissible hindsight reconstruction.

"The black rectangular box representing the stack being held by the clip was added by the Examiner to show that the device was indeed capable of applying a force to a portion of the perimeter of the stack...." (Examiner's Answer at pp. 8 – 9.)

It is neither known nor desirable to use a clip to clamp a stack having a dimension that is substantially narrower than the clip itself. Stretching the limits of AAPA until it becomes a different reference –AFF— is not permissible.

The Examiner's Answer alters the prior art to mold AAPA into the image of Appellants' invention (see page 6). This new reference AFF is improperly being relied on, because 1) it arose after the filing date of Appellants' application, and 2) such a combination—a narrow tray with the apparatus of Figure 4—would not be considered by one of ordinary skill in the art. Therefore, the Board is requested to overturn the 35 USC §102(b) rejection of Claims 1 – 4, 16 – 19, 28, 30, 32 and 33 over AAPA.

### III. Claims 8 – 11 are Nonobvious under 35 USC §103 over AAPA

#### A. Claims 8 - 11 are Patentable due to their dependence on Claim 1

Since Claim 1 is patentable, and has not been shown to be anticipated by AAPA or AFF, then claims 8 – 11 are also patentable.

B. Claim 11 is also Patentable because Resilient Members are Absent from AAPA

Both ends of the channel in AAPA lack structure corresponding to the resilient members of claim 2. The member 34 of AAPA extends upward within the central portion of the channel. Neither member 34 extends from the base on one end of the channel and from the base on a second end of the channel as recited in claims 2, 4, 11, and 19. The term “extending” connotes reaching upward. Of course, a mere glance at AAPA reveals that element 34 reaches upward into the central portion of the base instead of from each end of the channel as in Appellants’ invention. In summary, there is no suggestion in AAPA to modify element 34 and have it somehow extend from either end of the channel.

IV. Conclusion

Claims 1-4, 16-19, 28, 30, 32 and 33 are novel under 35 USC §102(b) because AAPA fails to teach: 1) applying force to a perimeter portion of a tray stack; 2) resilient members that extend upward from each channel end; and 3) a stack having a narrow dimension relative to the dimension of the clip itself. The AFF that the Examiner developed with hindsight reconstruction does not constitute prior art. Moreover, claims 8- 11 are non-obvious under 35 USC §103(a) for at least the same reasons as claim 1, from which these claims depend. Consequently, the contentions found in the Examiner’s Answer are insufficient to uphold the rejection of Claims 1 – 4, 1 – 19, 28, 39, 32 and 33. Therefore, Appellants respectfully request the Board of Patent Examiners to reverse the final rejections of Claims 1–4, 16 – 19, 28, 39, 32 and 33.

Respectfully submitted,



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